

REMARKS

Reconsideration and allowance of this application are respectfully requested. Claims 1, 10 and 11 have been amended. Claims 2 and 3 have been canceled. Claims 1 and 4-12 are all of the claims pending in the present application, of which claims 4-9 and 12 have been withdrawn. The rejections are respectfully submitted to be obviated in view of the amendments and remarks presented herein.

35 U.S.C. § 112, First Paragraph Rejection - Claims 10 and 11

Claims 10 and 11 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant has amended claims 10 and 11 to improve clarity. Support for the claim amendments is found in the specification on at least page 13, lines 8-24 and FIG. 2B. Therefore, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, are respectfully requested.

35 U.S.C. § 112, Second Paragraph Rejection - Claims 10 and 11

Claims 10 and 11 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As discussed above with reference to the 35 U.S.C. § 112, first paragraph rejection, Applicant has amended claims 10 and 11 to improve clarity. Therefore, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, are respectfully requested.

35 U.S.C. § 103(a) Rejection - Claims 1-3, 10 and 11 - Shigetomi et al. in view of Liu et al.

Claims 1-3, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shigetomi et al. (U.S. Patent Number 6,287,661; hereinafter “Shigetomi”) in view of Liu et al. (U.S. Patent Application Publication Number US 2003/0044559; “Liu”). The rejection is respectfully traversed.

As indicated previously, Shigetomi is directed to an information label which is to be placed on an optical disk. The label contains a base sheet, on which data or a display is placed, and an adhesive layer on the base sheet. The adhesive layer is used to adhere the label to the disk.

Additionally, a protective film may be placed over the display data on the base sheet (col. 2, lines 55-61), and a release liner can be applied to the surface of the adhesive layer (col. 3, lines 52-53).

The Examiner has maintained the allegations that Shigetomi discloses a thin film cover sheet which is adhered via adhesive film to a recording surface of a disk substrate of an optical disc, and refers to column 1, lines 6-7 of Shigetomi for this teaching. However, Shigetomi’s base sheet only adheres (through an adhesive layer and release layer) to a hard coat layer, which is separate and distinct from a recording layer of an optical disk. Shigetomi’s hard coat layer can not be considered as the recording layer in any interpretation of the reference.

Furthermore, the Examiner has also maintained that Shigetomi discloses a protective sheet which is peelably adhered on a surface of the resin film of the cover sheet, and relies on column 2, lines 55-57 of Shigetomi for this teaching. However, Shigetomi is actually silent on any characteristic details of the protect film. There is no teaching or suggestion in Shigetomi of the protect film being either “*peelably* adhered,” or adhered with an adhesive force AP₂ which is greater than or equal to adhesive force AP₁, as recited by claim 1 (emphasis added).

The Examiner has improperly concluded that just because Shigetomi discloses a release liner applied on the surface of the adhesive layer formed on the base sheet of the label, the resultant adhesive force would be required to be less than or equal to an adhesive force binding the protect film to the label. However, because Shigetomi is silent on such a relationship between these two adhesive forces, and also silent on the adhering force of the protect film itself, such a conclusion as made by the Examiner is improper and strictly hindsight, and thus is unsubstantiated by the cited references.

Furthermore, Liu does not remedy the deficiencies of Shigetomi, and as such, Shigetomi in view of Liu would not teach or suggest the claimed invention.

In particular, Liu discloses an apparatus which packs and stores recording media by using adhesive coated articles to selectively cause recording media to adhere to a backing surface. Adhesion of recording media to the adhesive coated article is relatively strong (as the recording media is a targeted surface), while adhesion of other materials such as paper to the adhesive coated article is relatively weaker than the adhesion of the recording media.

Although Liu teaches that reading sides of optical discs are secured to the adhesive coated articles, it is only the property of the adhesive which selectively adheres better to a material such as polycarbonate, of which the whole surface of exemplary optical discs are manufactured of. Liu thus fails to disclose or suggest an adherence of a thin film cover sheet via adhesive film to the disk substrate of an optical disk, because Liu only discloses adherence of an adhesive coated article to optical discs made of a particular material such as polycarbonate, which the adhesive coating would selectively adhere better to, as opposed to other materials such as paper.

Furthermore, Liu also fails to teach or suggest “a protective sheet which is peelably adhered on a surface of the resin film of the cover sheet,” as well as a relationship of adhesive force $AP_1 \leq AP_2$, as recited by claim 1. Although Liu discloses the application of different adhesive forces depending on the material with which the adhesive coated article adheres with, there is no mention or suggestion of the claimed relative relationship between the adhesive force adhering the peeling sheet to the adhesive film and the adhesive force adhering the protective sheet to the resin film, as recited by claim 1.

In addition, because Liu discloses an adhesive coated article for securing and storing optical discs, while Shigetomi discloses a totally unrelated label for optical disks, there fails to be a proper motivation or suggestion to combine the two references at least because of the variant and divergent manufacturing processes used to create the entirely different types of products (article for securing optical discs versus optical disk labels). Although both Shigetomi and Liu teach adhesives for attaching certain components, these two references are simply not

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combinable in the manner as suggested by the Examiner. The Examiner's conclusory obtainment of the claimed invention was only derived through the use of improper hindsight.

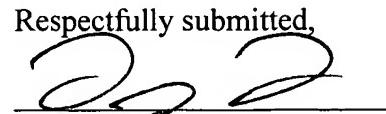
As such, Applicant respectfully submits that Shigetomi in view of Liu fails to teach or even suggest the claimed invention. At least by virtue of the aforementioned differences, Applicant's claim 1 distinguishes over Shigetomi in view of Liu. Applicant's claims 10 and 11 are dependent claims including all of the elements of independent claim 1, which as established above, distinguishes over Shigetomi in view of Liu. Therefore, claims 10 and 11 are patentable over Shigetomi in view of Liu for at least the aforementioned reasons as well as for their additionally recited features. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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